REMARKS

Claims 1-23 are pending in the application.

Claims 1-23 have been rejected.

Claims 1-3, 5-6, 9, 11-18 and 21-23 have been amended, as set forth herein.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1, 2, 4, 5, 12-14, 16 and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Baiyor, et al. (US 6,574,325 B1). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent Claim 1 (method) and Claim 13 (computer readable medium) each recite, inter alia, (1) accessing a database for a record corresponding to said DN, (2) determining, based upon information associated with said record, whether call forwarding is active, and (3) in response to determining that call forwarding is active, initiating one or more outgoing calls to one or more forwarding numbers while leaving said incoming call unanswered. Independent Claim 12 (method) recites, inter alia, accessing a database for a record corresponding to said

incoming telephone call, and (2) determining, based upon information associated with said record, whether call forwarding is active, and in response to determination that call forwarding is active, retrieving forwarding location information from said database.

Baiyor fails to disclose accessing a database for a record corresponding to said DN (or incoming telephone call) and determining, based upon information associated with the record, whether call forwarding is active, and if active, initiating one or more outgoing calls. Baiyor recites that when a call is placed to a special directory number (referred to as either a pilot DN or primary DN), the call is directed to multiple different secondary DNs. See, Col. 3, line 58 thru Col. 4, line 28. Baiyor does not determine whether call forwarding is active from a record in the database (associated with the DN or incoming call), as Baiyor automatically initiates the outgoing calls upon receiving the incoming call to the special DN (i.e., Baiyor does not make a determination whether to make the outgoing calls to the forwarding numbers/locations or not). Therefore, Baiyor fails to disclose each and every element of Applicant's claimed invention, as set forth in independent Claims 1, 12 and 13.

Moreover, Baiyor fails to disclose that when the DN is associated with a subscriber line, an outgoing call is initiated to that subscriber line (see, Applicant's dependent Claims 4 and 16). Baiyor does not disclose initiating an outgoing call to a specific subscriber line (telephony device) having the DN of the incoming call.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-3, 5-6, 9, 11-18 and 21-23.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 3, 6-11, 15, and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baiyor, et al. (US 6,574,325 B1) in view of Otto (US 6,163,606) or Brennan (identification unknown). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As set forth above in response to the 102 rejection, Baiyor fails to disclose one or more elements/features recited in Applicant's independent Claims 1, 12 and 13 (as amended). Neither of the secondary references appear to disclose, teach or suggest these elements/features as well. Therefore, none of the cited references, either alone or in combination, disclose teach or suggest Applicant's invention as claimed.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 3, 6-11, 15 and 18-23.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***rmccutcheon@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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